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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,050	03/15/2004	David A. Cheresch	TSRI 651.7	2305
<div>7590 OLSON &amp; HIERL, L.TD. 36th Floor 20 North Wacker Drive Chicago, IL 60606</div>				
<div>06/17/2008</div>				
<div>EXAMINER VAKILL, ZOHREH</div>				
<div>ART UNIT 1614</div>				
<div>PAPER NUMBER</div>				
<div>MAIL DATE 06/17/2008</div>				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/801,050

**Applicant(s)**

CHERESH ET AL.

**Examiner**

ZOHREH VAKILI

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-20 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-20 and 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Claims 7-20 and 37-40 are presented for examination.**

Applicant's Amendment filed February 6, 2008 has been received and entered into the present application. Claims 7-20 and 37-40 are pending and are herein examined on the merits.

Applicant's arguments, filed February 6, 2008 have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

***Claim Rejections - 35 USC § 112 first paragraph***

**LACK OF WRITTEN DESCRIPTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH:**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 12-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 8, 12-20 are directed to encompass inhibitors which only correspond in some undefined way to specifically instantly disclosed chemicals. None of these inhibitors meet the written description provision of 35 USC § 112, first paragraph, due to lacking chemical structural information for what they are and chemical structures are highly variant and encompass a myriad of possibilities. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*. (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116).

With the exception of the above specifically disclosed chemical structures, the skilled artisan cannot envision the detailed chemical structure of the encompassed inhibitors, derivatives, analogs, etc., regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The chemical structure itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, University of California v. Eli Lilly and Co.,

43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the above chemically structurally defined chemicals, but not the full breadth of the claim(s) meet the written description provision of 35 USC § 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115).

***Claim Rejections - 35 USC § 112, First Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for the prophylactic treatment of the disease. The specification does not enable any person skilled in the art to which it pertains to make or use the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per the factors indicated in the decision *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988) As to undue experimentation.

The factors include:

- 1) the nature of the invention;
- 2) the breadth of the claims;
- 3) the predictability or unpredictability of the art;
- 4) the relative skill of those in the art;
- 5) the amount of direction or guidance presented;
- 6) the presence or absence of working examples;
- 7) the quantity of experimentation necessary;

Each factor is addressed below on the basis of comparison of the disclosure, the claims and the state of the art in the assessment of undue experimentation.

- 1) the nature of the invention; the invention is directed to a process for prophylactic

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treatment of myocardial infarction.

- 2) the breadth of the claims; the scope of the method claims include the prophylactic treatment of myocardial infarction.
- 3) the predictability or unpredictability of the art; the art does not enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. The burden of enabling one skilled in the art for prophylactic treatment of myocardial infarction would be much greater than that enabling the treatment. In the instant case, the specification does not provide guidance as to how one skilled in the art would accomplish the objective of prophylactic treatment of myocardial infarction. Nor is there any guidance provided as to a specific protocol to be utilized in order to show the efficacy of the presently claimed active ingredients for prophylactic treatment of myocardial infarction. No experimental evidence or mechanism of action for supporting prophylactic treatment of myocardial infarction using the specified actives by simply administering, by any method, an amount of the claim specified active agents. The specification fails to enable one of ordinary skill in the art to practice the presently claimed method for prophylactic treatment of myocardial infarction. It is unpredictable for prophylaxis practice with a chemical administration as instantly claimed. The specification is viewed as lacking an adequate enablement of where myocardial infarction may be actually prophylactic treated.
- 4) the relative skill of those in the art; the relative skill of those in the art of pharmaceuticals is high.
- 5) the amount of direction or guidance presented; the specification and the example

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does not provide any guidance in terms of prophylactic treatment of myocardial infarction.

6) the presence or absence of working examples; no working examples are provided for prophylactic treatment of myocardial infarction, for example in a patient, in the specification. The applicant has not provided any competent evidence or disclosed any tests that are highly predictive for the preventative effects of the instant composition. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

7) the quantity of experimentation necessary; the quantity of experimentation would be an undue burden to one of ordinary skill in the art and amount to the trial and error type of experimentation. Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant process claims. In view of the breadth of the claims, the chemical nature of the invention and unpredictability of prophylactic treatment of myocardial infarction, and the lack of working examples regarding the activity as claimed, one skilled in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

In consideration of each of factors 1-7, it is apparent that there is undue experimentation because of variability in prediction of outcome that is not addressed by



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the present application disclosure, examples, teaching and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-20 and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Boschelli et al.; Optimization of 4-Phenylamino-3-quinolinecarbonitriles as potent Inhibitors of Src kinase Activity, J. Med. Chem. 3965-3977, 2001.

Boschelli et al. teach that Tyrosine kinases Src is the prototype member of the Src family of kinases, which share a common structural organization and are highly homologous in their ATP-binding regions. Inhibition of Src activity could be efficacious for the treatment of various diseases. Boschelli et al. further teach that Src inhibitors prevents injury that results from vascular endothelial growth factor mediated increase in vascular permeability. Boschelli et al. also teach the compound

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quinolinecarbonitrile as a Src inhibitor (see page 3965, col. 1 & 2). Thus Boschelli et al. anticipate all of the instant claims.

Claims 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Das et al. (US Patent Application 2002/0123484).

Das et al. teach methods of treating diseases including myocardial infarction using tyrosine kinase inhibitors (see paragraph [0164]). These compounds are disclosed as inhibitors of tyrosine kinases including Src kinases (see paragraph [0161]). Das et al. further teach that these compounds can be administered by intravenous injection, orally or parentally (see paragraph [0170]). Preferred subjects for treatment include animals, most preferably mammalian species such as humans, and domestic animals such as dogs, cats and the like, subject to protein tyrosine kinase-associated disorders (see paragraph [0176]). Thus Das et al. anticipate all of the instant claims.

Claims 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Barrish et al. (US Patent 6,235,740).

Barrish et al. teach methods of treating diseases including myocardial infarction using tyrosine kinase inhibitors (see column 17, line 66 – column 18, line 6). These compounds are disclosed as inhibitors of tyrosine kinases including Src kinases (see column 17, lines 34-36). Barrish et al. further teach that these compounds can be administered by intravenous injection, orally or parentally (see column 19, lines 33-38).

Preferred subjects for treatment include animals, most preferably mammalian species such as humans, and domestic animals such as dogs, cats and the like, subject to protein tyrosine kinase-associated disorders (see col. 20, lines 50-54). Thus Barrish et al. anticipate all of the instant claims.

Applicant's amendments and remarks have been carefully considered in their entirety, but fail to be persuasive in establishing error in the propriety of the present rejection.

### ***Conclusion***

No claims of the present application are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Vakili whose telephone number is 571-272-3099. The examiner can normally be reached on 8:30-5:00 Mon.-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Zohreh Vakili

Patent Examiner 1614

May 27, 2008

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614